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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/468,015	12/20/1999	DIETMAR EGGERT	F71989US	3122

23720 7590 12/04/2003

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EXAMINER

HUYNH, KIM NGOC

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 12/04/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/468,015

Applicant(s)

EGGERT ET AL.

Examiner

Kim Huynh

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

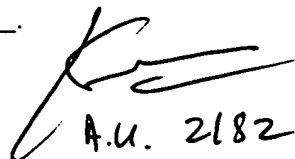
Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: _____

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____


A.U. 2182
Primary Examiner

Response to Arguments

1. Applicant's arguments filed 11/4/03 have been fully considered but they are not persuasive.

a. Applicant argues that Waga does not disclose the plurality of ESD devices, the examiner respectfully disagrees; the ESD devices are indicated by capacitors 26. The examiner also disagrees with applicant's argument that since Waga does not use the term ESD devices, the capacitors 26 of Waga do not function as ESD devices.

Regardless of the use of the capacitor 26 of Waga, please note a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this instant, please note that the thin film device in Fig. 10 of Waga provides the identical structure of Fig. 2 of applicant's own invention and claimed limitation. Please also applicant's own admission that ESD devices can be in various forms including Zener diodes, capacitors and other controlled breakdown or surge filtering devices (p.2, ll.12-14).

b. Applicant argues that Lee does not disclose the plurality of ESD devices, please note the examiner explains that though Lee does not disclose a plurality of ESD

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devices connecting to the corresponding coil turn, the ESD or capacitance formed between the conductive layers are inherent according to the laws of physics, and thereby forming a plurality of ESD devices.

The examiner further points out that this property are further support by the structure of the thin film device as disclose in Waga and also is in the exact manner as applicant's embodiment. Please note Figs. 1-4 of Lee show the identical structure of applicant's own invention (Fig. 4). Again applicant seems to argue that Lee does not read on the claimed invention just because Lee does not use the same terminology as preferred by applicant. The examiner again respectfully disagrees with this line of argument.

c. As for the argument regarding the plurality of ESD clamps, the claims defines an ESD clamp as being corresponding to a turn of the plurality of the inductor, please note both Waga and Lee discloses the inductor having multiple turns.